Supreme Court of the United States,

OCTOBER TERM, 1899.

NUMBER 149.

MAST, FOOS & COMPANY,
Petitioner,
vs.
STOVER MANUFACTURING COMPANY.

ON WRIT OF CERTIORARI TO THE UNITED STATES CIRCUIT COURT OF APPEALS FOR THE SEVENTH DISTRICT.

BRIEF FOR PETITIONER.

I.

This cause comes to this Court on certiorari. A petition for this writ was filed October 10th, 1898. The petition was duly allowed, and cetiorari and return filed October 31st, 1898.

Two grounds for the writ were set forth in the petition. (1) A conflict and variance of decision between the Circuit Court of Appeals for the Eighth Circuit, who pronounced judgment on a final hearing upon regular pleadings and full proofs, and the Circuit Court of Appeals for the Seventh Circuit, who pronounced a conflicting decision without complete pleadings, on *ex parte* affidavits in an interlocutory matter; and (2) a matter of procedure adopted by the Circuit Court of Appeals for the Seventh Circuit, namely, the dismissal of the

petitioner's bill of complaint, on such *ex parte* affidavits, in such interlocutory proceeding, to-wit: on appeal by the Stover Manufacturing Company from an order by the Circuit Court for the Northern District of Illinois, (Judge Grosscup) granting a preliminary injunction; such dismissal of the bill, "for want of equity," under such conditions, depriving the petitioner of the right of trial of its cause.

This is the substance of the petition for the writ of certiorari which this Honorable Court promptly allowed. Accordingly, the case is now before this Court for review.

In *Mast, Foos & Co.* v. *Dempster Mill Mfg. Co.* (August 2, 1897), 27 C. C. A. 191, the patent here in suit was sustained by the Circuit Court of Appeals for the Eighth Circuit, upon full pleadings and proofs. The defendant here, the Stover Mfg. Co., had virtually assumed the defense of that case, its attorney, Mr. Morrison, examining and cross-examining the witnesses, entering into stipulations respecting the conduct of the case, submitting briefs, and arguing the cause at the hearing. The mill made by the Dempster Co. was substantially the same as that made by the Stover Co., and the latter company was, therefore, extremely anxious that the Dempster mill should not be held tributary to the Martin patent. (See transcript, sec. 9 of bill, pp. 4–5.)

Subsequently to the final decision of the Circuit Court of Appeals at St. Louis as aforesaid, Mast, Foos & Co., November 19, 1897, brought the present suit, at Chicago, against the Stover Mfg. Co. for an accounting of profits and damages and to enjoin the defendant from proceeding with its infringement of the Martin patent, and, on the same day, moved for a preliminary injunction. The defendant

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appeared by its attorney who had defended its interests in the Dempster case, and also by Messrs. Offield, Towle and Linthicum, and filed a number of *ex parte* affidavits, copies of prior patents, trade circulars, and other exhibits. The complainant filed counter affidavits, and the application for a preliminary injunction came up for hearing before Judge Grosscup *on ex parte evidence alone, not a word of testimony having been taken at that time nor since.* Judge Grosscup withheld his decision for a long time, in order to study and thoroughly consider the opinion of the Circuit Court of Appeals in the Dempster case, and to satisfy himself whether the new *ex parte* evidence, if if it had been duly and regularly before the Court in the Dempster case would have caused the Circuit Court of Appeals for the Eighth Circuit to modify in any way the conclusions at which it arrived. The reasoning of that Court in its opinion was very clearly stated, and Judge Grosscup became convinced that it fully covered the new *ex parte* evidence, and that the latter, if before it, would not have affected the result; and, regarding the decision in the Dempster case as an authoritative judgment sustaining the validity of the patent and pronouncing it infringed by machines of the Stover type, he, on the 31st day of January, 1898, *before the filing of defendant's answer*, unhesitatingly granted the preliminary injunction prayed for. The Defendant appealed under the seventh section of the Act of March 3, 1891, and the appeal came on for hearing before the Circuit Court of Appeals at Chicago. That Court (32 C. C. A. 231 and Transcript, p. 95) proceeded, not to overrule the injunction order, but to dismiss the bill—and this it did, on the ground that the *Defendant's ex parte affidavits had overcome the proofs*

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presented in the Dempster case and had conclusively established the invalidity of the Martin patent.

Upon these facts, two questions of law arise for determination by this Court, to wit: — (1) Was the dismissal of the bill right or wrong? and (2) Is the so-called "Rule of Comity" between the federal courts to be maintained or not?

As against the action of the Circuit Court of Appeals at Chicago, we make the following points:—

1. That in a patent infringement suit for an injunction and accounting, the Court has no legal authority to dismiss such a bill on the mere strength of representations found in *ex parte* affidavits taken for use on a motion for preliminary injunction. The law requires that, on the merits of the case, the Court shall act only on proofs duly and regularly taken; and that the rights of proper cross-examination and rebuttal shall not be denied.

It seems unnecessary to argue a proposition so self-evident to every person who knows anything of the spirit and meaning of Anglo-Saxon law; and it is quite impossible to support such an argument by citation of federal precedents, for the reason that, until the present instance, all of the United States Courts have apparently taken this proposition for granted, without question or comment. There are plenty of authorities, however, in the State reports, that when a bill prays for injunction *and other relief*, it is error to dismiss it upon the hearing of an injunction motion, without allowing the case to proceed regularly to final hearing upon full proofs. *Hummert* v. *Schwab*, 54 Ill. 142; *Brockway* v. *Rowley*, 66 Ill. 99; *Pullen* v. *Baker*, 41 Tex. 419; *Strong* v. *Harrison*, 62 Miss. 61; *Walsh* v. *King*, 74

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Mich. 350; *Makemson* v. *Kauffman*, 35 Ohio, 444; *Augusta National Bank* v. *Printup*, 63 Ga. 570; *Johnston* v. *Alexander*, 6 Ark. 302; *Robinson* v. *Mays*, 76 Va. 708; *Noyes* v. *Vickers*, 39 West Va., 30; *Knox* v. *Coroner*, 13 La. Ann. 88; *Zeigler* v. *R.R. Co.*, 58 Ala. 599.

So far as concerns the federal courts, the law is perfectly clear upon this subject. The Constitution itself provides that "No person shall be deprived of life, liberty or property without due process of law." Due process of law means, "In the due course of legal proceedings, according to those rules and forms which have been established for the protection of private rights." (*Cooley on Const. Lim.* 355.) "In judicial proceedings the law of the land requires a hearing before condemnation, and judgment before dispossession." (Id. 356.) The constitutional expression "due process of law" "must, therefore, have intended the ancient established law and course of legal proceedings, by an adherence to which our ancestors in England, before the settlement of this country, and the emigrants themselves and their descendants, had found safety for their personal rights." (Chief Justice Shaw, in *Commonwealth* v. *Honeman*, 127 Mass. 450.) Kent (2 Com. 13) says: "The better and larger definition of 'due process of law' is that it means law in its regular course of administration through courts of justice." (See, also, *Murray's Lessee* v. *Hoboken, &c. Co.* 18 How. 272, 280; *Walker* v. *Sauvinet*, 92 U. S. 90, 93; *Hurtado* v. *California*, 110 U. S., 516.) The "ancient established law and course of legal proceedings," both at law and in equity, required that each litigant should have the right to cross-examine his opponent's witnesses, and to rebut their evidence (*Zeigler* v. *R. R. Co.*, *Supra*); yet,

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by the action of the Circuit Court of Appeals for the Seventh Circuit, the Complainant's property is destroyed without the slightest opportunity being given for the exercise of these ancient and invaluable rights.

Section 862 of the Revised Statutes provides that the mode of proof in equity causes shall be according to rules now or hereafter prescribed by the Supreme Court. The Supreme Court has prescribed Rules 67, 68 and 69 for taking testimony in equity cases; but it has never prescribed a rule allowing the parties to prove their case by *ex parte* affidavits. The Act of March 9, 1892 (27 St. at Large, 7) also allows evidence to be taken in the mode prescribed by the laws of the State in which the courts are held; the laws of Illinois provide that evidence in chancery shall be taken by deposition, upon several days' notice, and with the right of cross-examination. (*Myers' Ill. Rev. St.*, Ch. 51, Sects. 24 to 38.) The Circuit Court of Appeals, therefore, dismissed the bill upon evidence taken in violation of the express requirements of the statutory Rules of this Court, and of the statutes of Illinois.

2. The appeal, taken under section 7 of the Act of March 3, 1891, did not bring up the "merits" of the case, but only the question whether the Judge below had, in granting the injunction, exercised his discretion providently or improvidently. (*Atwater* v. *Castner*, 32 C. C. A., 77.)

There were no "merits" for the appeal to bring up; the pleadings had not been completed, and not a word of evidence had been taken in the case; hence, the case could not be heard on anything but the motion, except by consent, and consent was not given. The action of the Chicago Court of Appeals was,

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therefore, a clear usurpation of judicial authority.

In thus assuming to act upon the merits of the whole case, the Court understood itself to be justified under the decision of the Supreme Court in *Smith* v. *Vulcan Iron Works*, 165 U. S. 518. But, in *Smith* v. *Vulcan Iron Works*, the appeal *did* bring up the merits of the whole case, because it was an appeal from a decision of the Court below upon the merits of the whole case and based upon complete pleadings and full proofs regularly taken and submitted. The difference between that case and the case at bar is world-wide—there, the appeal brought up the merits, because they had been regularly and legally adjudicated by the Court below; here, there were no merits to be brought up by the appeal, because the judge below had not assumed the power to pass upon the merits, and because the case had not reached a stage where the merits could be adjudicated. The appeal probably brought up the *whole record;* but the record consisted of nothing but bill and *ex parte* affidavits, and furnished no basis for any conclusion as to the merits. The principles stated by this Court in *ex parte Sanford Fork & Tool Co.*, 160 U. S. 247, and *ex parte Potts*, 166 U. S. 263, seem controlling of the whole matter.

The Chicago Court of Appeals, when it stretched the language of *Smith* v. *Vulcan Iron Works* away beyond the intention and meaning of the Supreme Court, did not observe that it was thereby stultifying this Court, by assuming that it was capable of acting in open and plain violation of the statutory rules prescribed by itself for taking evidence in equity cases, and of countenancing the destruction of people's property rights without any regard to "due process of law." The whole reasoning

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of the Court of Appeals, as found on p. 234, 32 C. C. A., is colored by this strange forgetfulness of the fundamental requirements of the law. And, as an illustration of how error leads to error, the Court winds up its discussion by finding itself logically driven to the abolition of the Rule of Comity, whose death sentence it pronounces in the two concluding paragraphs of the discussion.

3. Under the directions contained in said concluding paragraphs, the Circuit Courts of the Seventh Circuit are admonished, in effect, that upon every application for an injunction or temporary restraining order, they should hear and determine the case on its merits, without regard to the question whether it has been duly and regularly prepared for such hearing or not, *and without allowing themselves to be governed by the prior findings of any other Court, original or appellate.* It would seem to follow logically from these instructions, that even in a case where the Supreme Court had pronounced final judgment upon the merits of the controversy, the Circuit Courts of the Seventh Circuit would, in any later case where a preliminary injunction or restraining order had been applied for on the strength of the Supreme Court judgment, be obliged, upon mere *ex parte* affidavits, to reopen the whole question and sit in judgment upon the findings of the Supreme Court. The action of Judge Grosscup in the Circuit Court was overruled precisely because he did not take this position with respect to the judgment of the Circuit Court of Appeals at St. Louis—a judgment which, while unreversed, ought to be accorded, so far as concerns interlocutory motions, the same force and dignity as a judgment of the Supreme Court. And it will be noticed that the new rule here attempted to be established

by the Court of Appeals at Chicago is not confined to patent cases, but covers every case in which a preliminary injunction or restraining order may be applied for. Under that rule, the lawyer who moves for such an injunction or order, in any kind of suit, runs the grave risk of having his clients' case finally adjudicated and dismissed upon *ex parte* affidavits produced by his opponent—no matter by how many adjudications by other courts of equal or higher dignity his right to such relief may have been already established.

The "Rule of Comity" thus summarily swept aside has been universally regarded as being, so far at least as concerns the federal system of courts, a rule of the highest wisdom and expediency. The exact nature of the rule, and the reasons for enforcing it, were never stated more clearly and satisfactorily than in *Electric Mfg. Co.* v. *Edison Electric Light Co.*, (10 C. C. A., pp. 107, 108, 109—May 1, 1894) by the very Court which has now undertaken to abolish it. In *Beach* v. *Hobbs*, 82 Fed. Rep., 916 to 921, Judge Putnam, of the First Circuit, stated clearly the absolute necessity for the rule, and the expediency of applying it to the Circuit Court of Appeals as to the Circuit Courts, remarking, in a foot note to p. 919, that the same rule prevails among the subordinate courts of appeal in England; and the Circuit Court of Appeals for the First Circuit afterwards, in the same case (92 Fed. Rep. 146,147), approved his position. Pages of discussion would add nothing to the clearness and cogency of the reasoning of Judges Putnam and Jenkins in the cases cited.

Without the rule of comity, the federal judicial system would be like a rope of sand. Each Court would be entirely independent of all others, and would regard the opinions of

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other courts of co-ordinate or appellate jurisdiction merely as arguments found in a brief, to be followed when approved or disregarded when not approved. No principle of law or question of fact would be settled by any judgment, and "confusion worse confounded" would inevitably result. All sorts of decrees would be made in the different circuit courts upon the same state of facts. If there is to be any uniformity or system in the action of the federal courts the Rule of Comity must be maintained. It is not only a rule of convenience to the courts themselves, but of inestimable value to litigants, who are interested in having some definite result follow from the decision of a competent court in their favor.

Owing to the limited scope of the Rule, and the fact that its application is mainly confined to interlocutory proceedings, the Supreme Court has never, so far as we are aware, been required to pass upon its validity or propriety. It would be of great value to the bench, the bar, and the public, to receive from this Court an authoritative and final pronouncement upon this subject, to the end that we may know whether the lower courts, especially on applications for preliminary injunctions and restraining orders, exercise a proper discretion by complying with the Rule. The case at bar seems to call for such final and authoritative pronouncement; for, if the decree of the Circuit Court of Appeals dismissing the bill be set aside, as we assume it will be, this Court will then, undoubtedly, proceed to pass upon the propriety of Judge Grosscup's action in awarding the preliminary injunction. This, as we understand the law, was the only question raised by the appeal from Judge Grosscup's order, and the only question upon which the Circuit Court of Appeals had authority to pass.

Judge Grosscup had nothing to act upon except the bill, the *ex parte* affidavits, and the record of the case that had been sustained by the Circuit Court of Appeals of the Eighth Circuit. He found infringement perfectly clear (Tr. p. 77.) Under such circumstances he could not, and did not attempt to, pass upon the merits of the case, but only upon the propriety of issuing the preliminary injunction prayed for. In considering the latter question, he held that, in the exercise of his discretionary power, he was constrained by the Rule of Comity to follow the judgment of the St. Louis Court as to the validity and scope of the Martin patent, citing the Edison case, 10 C. C. A., 107–109 (*supra*). If in so doing he exercised his discretion properly, then his order was right and should be sustained by this Court. If otherwise, then his order was wrong, and the Circuit Court of Appeals should have set it aside without dismissing the bill. The question, therefore, now squarely arises for decision by this Court as to whether, on an application for a preliminary injunction or restraining order in a patent infringement suit, heard upon *ex parte* affidavits, it is proper practice for the Circuit Court or Judge, or the Circuit Court of Appeals, to consider as practically binding, upon the question of validity, and upon the question of infringement, when the alleged infringing structures are practically the same, a prior final adjudication of those questions upon full pleadings and proofs, by another Circuit Court, or Circuit Court of Appeals, in a suit between other parties, where the contest was bona fide; new evidence and differences between the infringing structures being, of course, matter for independent consideration, or whether, on the other hand, in

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such proceedings all semblance of uniformity and orderly action among the Federal Courts is to be brushed away, and indescribable confusion, uncertainty, and expense to the owners of patent property, are to result. We submit that question with entire confidence that this Court will declare itself on the side of a uniform, orderly, and consistent system of procedure in the Federal Courts.

II

Pending the appeal to the Circuit Court of Appeals for the Seventh Circuit, upon the application of the defendant, His Honor, Judge Grosscup, made the following order:

"This cause coming on to be heard before "the Court on defendant's motion to restrain "complainant from prosecuting and bringing "suits for infringement of the patent herein "against agents and representatives of defen- "dant who sell windmills *purchased* from de- "fendant. * * * *

"It is ordered as follows: That the super- "sedeas bond allowed herein protects defen- "dant's said Agents and representatives as to "windmills *purchased* by them from defendant "herein, since February 2nd, 1898,(date of said "appeal bond.)

"That said effect of said bond shall *operate* "*during the pendency of the appeal* to the "Circuit Court of Appeals for the Seventh "Circuit, lately taken by defendant herein "from an order of this Court awarding a "preliminary injunction to the complainant "against the defendant, such injunction being "superceded and such bond accepted in lieu "thereof.

"Approved April 11th, 1898." (See pages 9, 10 Petition for Writ of Ceriorari.)

This Court will see that the effect of this order was to enjoin Mast, Foos & Company from suing sellers and jobbers who dealt in

defendant's infringing windmills, such effect operating pending the appeal to the Circuit Court of Appeals for the Seventh Circuit. We contended then, and contend now, that such order so enjoining Mast, Foos & Company was wrong because the supersedeas bond given by the Stover Manufacturing Company for its acts, (Trans. p. 83) could not protect the complainant from the acts of third parties, namely, jobbers selling infringing windmills in distant circuits, and particularly that such order was wrong where the patent had been sustained in the Court of Appeals for the very Circuit where such jobbers were operating.

We now ask this Court to make such disposition of that order as will advise this Complainant what its status will be under said order in the event that this Court should, among other things, direct the Circuit Court of Appeals for the Seventh Circuit to reinstate this case upon its docket. Infringers are selling infringing Stover windmills, against the trade of Mast, Foos & Company, in the Eighth Circuit, and under this order Mast, Foos & Company have been deprived of the right to proceed against such infringers in the very Circuit where the highest Court has sustained the patent.

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III.

THE PATENT.

There are two matters for this Court's consideration brought out under this head:

(1) *Whether the record of the prior art and of the facts herein, modified, in legal effect, the Dempster case, as exhibited in the opinion of the Circuit Court of Appeals for the Eighth Circuit and in the opinion of Judge Grosscup so as to justify the Circuit Court of Appeals for the Seventh Circuit in reaching a different conclusion from the former Court and in reversing the latter Court. We contend that the Stover case does not modify, in legal effect, the other case, and hence that the conclusion adverse to the Martin patent of the Circuit Court of Appeals for the Seventh Circuit was unjustifiable.*

(2) *Whether the record in the Stover case, if it did modify the record in the other case at all, in legal effect, was a sufficient modification to justify the conclusion of the Circuit Court of Appeals for the Seventh Circuit. We contend that the negative of this proposition is true. The following discussion supports these two contentions on our part.*

The Martin invention covered by the patent involved herein created a distinct advance in the art; that is why it is being copied. In modern pumping windmills the wheel is comparatively small and moves at a high speed. It is on top of a high tower, and at the foot of the tower is the pump, a reciprocating machine. The rotary motion of the wind wheel shaft must be transmitted to this pump, must be slowed down, and must be converted into reciprocating motion. This conversion of rapid rotary motion into slow reciprocating motion by means of external gear wheels and

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a pitman or plunger, brings about violent *shocks or chugs* due to the change of strain from pulling to pushing, which takes place at the dead centers. The shocks produce the peculiar noise heard of a still night near a wind mill. They loosen the attachments which unite the top rigging to the tower and necessitate the repairing of parts high up and inaccessible. They result in the breaking of teeth, in their rapid wear, in the dislocation of parts, and in other breakages.

The patent in suit says:

"The invention consists, essentially, of an "improved back gear organization involving "an external-toothed pinion and an internal "toothed spur-gear, the pinion being mounted "on the wheel shaft and the gear having formed "on or connected with it the wrist pin, to which "the operating-pitman is attached, whereby the "speed of the main shaft as applied to the "wrist pin is reduced, and whereby, also, all "pounding and lost motion is prevented as the "pitman connection passes over the center and "is prevented as the pitman connection passes "over the center and changes from a pulling "to a pushing action."

Again the patent says:

"The freedom of the organization from lost "motion and sudden jerks as the wrist pin "passes over the center renders the operation "of the pump smooth and regular. This "increases the effectiveness of the pump and "prevents undue wear and tear."

The first claim, the only one involved, is as follows:

(1) "The combination with a wind mill "driving shaft and a pinion thereon, of an "internal-toothed spur-wheel, mounted adjacent to said shaft and meshing with said pinion,

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"a pitman connected with the spur-wheel, and "an actuating-rod connected with the pitman."

For this combination, the Martin patent is the "ground floor or pioneer" patent. Such combination never existed before. We put forth this statement as undenied and undeniable. This Martin patent is the "ground floor" or "pioneer" patent for the modern "internal-gear pumping wind mill," as affirmatively appears from the decision of the Court of Appeals for the Eighth Circuit, where it says that prior to Martin's invention, "All wind mills had been driven by external-toothed spur-wheels," and that in such prior mills, as the cogs and other parts wore away, a pounding and racking motion of the machinery was caused, "as the pitman connection passed over the center and the motion changed from a pulling to a pushi' g one, or *vice versa*, * * shortening the life of the mill and sometimes stripping the cogs from the pinion." The Court then added: "The evidence is undisputed that this invention completely accomplished its purpose" (Trans. pp. 10, 11) and then that the Court answered the contention then made by the defendant in that case, and now made by the de'endant in this case, that the substitution of internal for external gearing in a wind mill (ignoring the fact that a *new combination* has been produced) in view of the common use of both forms of gearing in other machines in familiar use, was not invention, by declaring that it was "passing strange," if naught but the skill of the mechanic was required to make the improvement, "that no mechanic ever made it until after Martin discovered and described it." "Moreover," said the Court, "the *combination* of Martin immediately went into general use." (Trans. p. 13.)

We add that all this, so found by that Court, was then true, has remained true, and is not shown to be otherwise by anything in this record.

For a fuller presentation of the patent and conclusions reached by the Court for the Eighth Circuit, we quote as follows from its decision:

"All the witnesses on both sides of the cases "testified that the combination of the internal-"toothed spur-wheel with the pinion and the "other usual machinery of a wind mill and "pump is more useful and more valuable than "any other combination of elements in a wind "mill and pump yet discovered." (Trans. p. 10.) * * * *

"Prior to this invention, all wind mills had "been driven by external-toothed spur-wheels. "As the cogs on the spur-wheel and pinion and "the other parts of the machinery wore away, the spur-wheel and the pinion drew apart, and "as the pitman connection passed over the "center and the motion changed from a pulling "to a pushing one, or *vice versa*, a pounding "and racking of the machinery arose which "shortened its life and sometimes stripped the "cogs from the pinion. The object of Martin's "invention was to do away with this pounding, "and to prevent this wear and the strain of "the machinery. He accomplished this by "throwing aside the external-toothed spur-"gear and combining an internal-toothed spur-"gear with the pinion and the other necessary "elements of the wind mill, so that, as he says, " 'a plurality of the pinion teeth are always "engaged with the internal spur-gear, result-"ing in giving perfectly uniform, smooth and "noiseless reciprocating motion to the actuat-"ing rod, thereby prolonging the life of the "machine by saving it from constant jarring "and preventing wear and tear.' The evidence

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"is undisputed that this invention completely "accomplished its purpose." (Trans.pp.10, 11.)

On this matter Judge Grosscup, in allowing our injunction, stated in his opinion:

"Were the wheel an external-gear, inter- "meshing with the pinion M, this change of "strain would have alternately the tendencies "to tighten and then widen the interlacings of "the cogs. This, I infer, is what the Court of Appeals referred to." (Trans. p. 80.) * * *

"Martin's internal cog-wheel obviated this "trouble, inseperable to a combination of "wheel and pitman, by the fact, as stated in "his patent;" following with a quotation from the patent. (Trans. p. 80.)

Again the Court for the Eighth Circuit says:

"Finally the counsel for the appellee argue "that there is no patentable novelty in the "combination described in this claim, because "internal-toothed spur-wheels were old and "well known and the substitution of them for "the external-toothed spur-gear in the machin- "ery of wind mills was nothing but a *double* "*use*. This argument is always plausible and "persuasive where old elements have been "combined to produce a new or better result. "Each element taken by itself has its old effect "and it is always difficult to understand how "it was that the practiced eyes of the skillful "mechanic did not at once see and apply the "necessary remedy to the troublesome evil "which the invention removes."

"The fact, however, that such an evil long "existed and that no mechanic perceived or "applied the remedy is the most conclusive "evidence that something more than his eyes "and skill was required to discover and apply "the requisite device." (Trans. p. 12.)

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"Wind mills were old and their operation "was familiar to mechanics, but until that year" (the date of Martin's invention) "they went on "pounding their wheels with every stroke of "the pump rod, wearing themselves out prem- "aturely and occasionally stripping their pin- "ions of cogs for the lack of the *combination* "of this internal-toothed spur-wheel with the "other essential elements of their machinery. "If naught but the skill of the mechanic was "required to make this improvement, it is "*passing strange* that no mechanic ever made "it until after Martin discovered and described "it." (Trans. p. 12.)

Again the Court of Appeals for the Eighth Circuit said:

"The defenses were that there was no nov- "elty or utility in the combination of the "appellant and that the appellee did not "infringe it. In support of these defenses the "Mill Company introduced in evidence Letters "Patent 182,394, dated Sept. 19th, 1876, to "Edward Williams, for a new and improved "wind mill. * * A number of other Letters "Patent were introduced from which it appears "that the internal-toothed gearing had been "used, long before Martin made his invention, "to drive pinions which actuated wood-saws, "cutters of harvesting and mowing machines "and like parts of similar machinery." (Trans. p. 8.)

"It is true that internal-toothed spur-wheels "and their effect and their relative advantages "over external-toothed wheels had been famil- "iar to mechanics time out of mind."

"They had been used on mowing machines "and harvesting machines, on machines for "sawing wood and doubtless upon hundreds of "other machines, but no one had ever combined

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"one of these internal-toothed wheels with the "pinion, pitman and pump of a wind mill until "Martin made his invention in the year 1889." (Trans. p. 12.)

Then after quoting from and applying Mr. Justice Brown's statement of the law, in *Potts* vs. *Creager*, 155 U. S. 597, the Court for the Eighth Circuit concluded:

"The best evidence that the application of "the internal-toothed spur-wheel to the new "use of propelling the machinery of a wind "mill would not occur to a person of ordinary "mechanical skill is that it did not occur to "any of them in all the years in which wind "mills had been in use before Martin discov- "ered and applied it.

"*Thompson* vs. *Citizen's National Bank*, 10 "U. S. App., 500, 512, 513; 3 C. C. A., 518, "522, 523; 53 Fed. Rep., 250, 255; *Loom Co.* "vs. *Higgins*, 105 U. S. 580, 591; *Consolida-* "*ted Safety Valve Co.* vs. *Crosby Steam Guage* "*& Valve Co.*, 113 U. S. 157, 179; *Magowan* "vs. *N. Y. Belting and Packing Co.*, 141 U. S. "332, 341, 342; *The Barbed Wire Patent*, 143 "U. S. 275, 281, 283."

"Moreover, the *combination* of Martin imme- "diately went into general use. More than "3,000 wind mills which contained his *combi-* "*nation*, have been manufactured and sold "since 1890." (This was written in 1897, on a "deposition taken in May, 1895, so that the "3,000 referred to were sold between 1890 and "early in 1895, the first, and therefore the har- "dest years to introduce a device.) "*All* the "witnesses testified to its advantages over the "old combination which contained the exter- "nal-toothed gear, and the fact that the appel- "lee discarded the latter and substituted the "former, demonstrates its utility and advanta- "ges." (Trans. p. 13.)

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While in this present case the Stover Company did not discontinue using external gears on a part of its wind mills, it nevertheless adopted this internal gear *combination*, evidently because it was better, and experimented with the internal gear arrangement, as seen by its two letters on pages 51, 52, of the transcript; thereafter adopted it in spite of notices from this complainant not to use it, and continues to use it in spite of this litigation to prevent it.

Then the Court of Appeals for the Eighth Circuit concludes:

"The probative force of the patent, and of "the facts to which we have adverted, con- "strain us to hold that the *combination* "described in its first claim rose to the dignity "of an invention and was properly secured by "the Patent." (Trans. p. 13.)

Thus the Court of Appeals for the Eighth Circuit found six matters of fact, namely, (1) that In a pumping wind mill, the connection of the pitman to an external-gear driving wheel causes an injurious pounding, strain and wear of the mechanism (Trans. p.10); (2) that "The object of Martin's invention was to do away with this pounding, and prevent this wear and strain of the machinery" (Trans. p. 11); (3) that "The evidence is undisputed that this invention completely accomplished its purpose" (Trans. p. 11); (4) that "Internal-toothed spur-wheels, their effect, and their relative advantages over external-toothed wheels had been familiar to mechanics time out of mind" (Trans. p. 11); (5) that "No one had ever *combined* one of these internal-toothed wheels with the *pinion*, *pitman*, and *pump* of a windmill until Martin made his invention in the year 1889" (Trans. p. 12); and (6) that

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This *combination* is the essential thing claimed in claim one of Martin's patent. (Trans. p. 11.)

The defense was, that this combination, in view of the public familiarity with internal-toothed wheels, their effect and advantages, was an obvious one, within the skill of the mechanic and requiring no invention.

The Court overruled this defense upon the express ground that the *combination* was absolutely *new* and unique, and that if the *combination* had been obvious it would have been sooner thought of and used; that in view of the facts shown it was clearly not obvious; and that, therefore, the Martin claim was valid.

The Court did *not* put its decision upon the ground, that internal-toothed wheels had never been used in wind mills, or that they had never been used to drive wind mill machinery, but it put its decision clearly upon the ground that, *although* the pounding evil had long existed, nobody had ever discovered how to remedy it by this simple *combination.* This, with the "probative force" of the patent, operated to "constrain" the Court to "hold that the *combination* described in the first claim rose to the dignity of an invention, and was properly secured by the patent."

Thus will be seen, also, the reasons of the Court for not holding the Martin patent invalid on its face, a contention involved, in effect, in the proposition that it required no invention to produce the combination. But the utility and absolute novelty of the invention were too clearly recognized and understood by the Court to admit of upholding such a proposition. All this was argued in the Dempster case, and by Mr. Morrison acting at that time in the Dempster case for the defendant in this

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case, as pointed out above; was all considered by the Court of Appeals for the Eighth Circuit and was determined by that Court.

WHAT JUDGE GROSSCUP FOUND.

Judge Grosscup found, in this Stover case, that the new defenses, the Perkin's wind mill brought in by the new affidavits, and the additional patents also brought in, would not have made any difference with the Court of Appeals in St. Louis if they had been before that Court; or to use Judge Grosscup's own language:

"I am not convinced that the presence of "the Perkin's device in the case before the "Court of Appeals (Eighth Circuit) would "have changed its judgment. On the contra- "ry, I fell sure that the Court, holding to its "other postulates, would have *classed* the Per- "kin's device with the *others* referred to, as "being no such sufficient anticipation of the "*thought* embodied in the Martin invention as "to invalidate its patentability." (Trans. p. 81)

As showing that the additional patents above mentioned, (which are recited in the statement by the Court of Appeals for the Seventh Circuit, but not mentioned in its opinion,) were also within the art as known to and acknowledged by the Court of Appeals for the Eighth Circuit, his Honor, Judge Grosscup said:

"I have looked carefully through all previ- "ous patents, brought specially to my attention "as not having been in the case in the Eighth "Circuit, and am convinced that the internal "gear, shown in each of them, had no function "relating to the driving of the shaft, or the "creation of reciprocal action. The function "of the internal-gear appliance, in nearly all

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"of these cases, was merely to keep the wheel "in the wind. I do not feel *that the presence "of this information, in the mind of the Court of "Appeals, would have changed its judgment, "respecting the validity of the patent.*" (Trans. p. 78.)

Thus Judge Grosscup classed the Perkin's mill, brought in by the new affidavits, and classed the particular patents pressed upon his attention by counsel for the Stover Company, as their selection from the large book of patents they produced then and now produce again, with the patents considered and referred to by the Court of Appeals for the Eighth Circuit. Thus also Judge Grosscup did not find the Martin patent invalid because of these new defenses. So that, according to Judge Grosscup's well considered opinion, the St. Louis Court has, in effect, passed adversely on these new defenses, and he himself has likewise passed upon them "as being no such sufficient anticipation of the *thought* embodied in the Martin invention as to invalidate its patentability;" and because he was "convinced that the internal gear shown in each of them had no function relating to the driving of the shaft" (pump rod) "or the creation of reciprocal motion."

Thus also, *on* this *adjudication*, the present record is *not different* from the record before the Court of Appeals for the Eighth Circuit; *not different in kind and legal effect.* Judge Grosscup's conclusion on these mechanical questions is amply supported also by the affidavits of Mr. C. A. Bauer, (Trans. p. 71,) a very able statement by an able Mechanical Engineer, and the ablest, up to the time of his recent demise, in the State of Ohio; and the affidavits of Coffield, (Trans. p. 68,) Martin, (Trans. p. 73) and McNair, (Trans. p. 75.)

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WHAT THE COURT OF APPEALS FOR THE SEVENTH CIRCUIT FOUND.

The following extracts from the opinion of the Court of Appeals for the Seventh Circuit show that that Court acted entirely on the strength of the matters brought out in the new affidavits and the additional patents; and also that, but for those affidavits and additional patents, being principally the Perkin's mill and the patents recited in the statement by that Court, but not mentioned in its opinion, the Court for the Seventh Circuit would have approved the decision of the St. Louis Court. We have argued, and we think shown above, that the Court for the Seventh Circuit was wrong in finding the patent void and dismissing the bill on *ex parte* proofs, on an interlocutory motion. Our present proposition is that even if that course were right, in procedure, the conclusion reached on such *ex parte* proof, being in conflict with the decision in the Eighth Circuit was, first, wrong because, as pointed out by Judge Grosscup, the new evidence was within and was covered by the reasoning and scope of the St. Louis decision, and, second, that it was wrong as an independent conclusion of law, since there is nothing in the new evidence to sufficiently modify the original case to defeat the patent or the right to the preliminary injunction awarded by Judge Grosscup.

Thus the Court of Appeals for the Seventh Circuit, after quoting from the St. Louis opinion, "The evidence is undisputed that this invention completely accomplished its purpose," added: "*Certainly a remarkable success, as stated, and well worthy of a patent.*" But also added: "But the proof in the present record shows no such merit." (Trans. p.

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99) Again, that "the proof in this case shows that the prior form of construction was by no means superseded by the new" etc., etc. (Trans. p. 99.) Still again "That the improvement was not incorporated in wind mills sooner on the proof here made is not strange." (Trans. p. 100.) And once more, that "other considerations aside, the proof of the prior art in this record is different from and far more extensive than it was in the Dempster case." (Trans. p. 100.)

Thus it is clear that the Court for the Seventh Circuit, held, in effect, that on the facts in the Eighth Circuit the invention "was well worthy of a patent," and that that Court properly sustained it, while on the facts presented on these *ex parte* affidavits the invention was not worthy of a patent.

It treated the *ex parte* affidavits and *ex parte* defenses, such as the Perkin's prior use, and the additional patents, as making out a modification of the Dempster case, or a case modified, in some particulars, from the Dempster case. On the strength of these *ex parte* alleged modifications, it proceeded to annul the patent and dismiss the bill "for want of equity."

We contend (A) that the Court for the Seventh Circuit was wrong in its procedure, as pointed out in the first branch of this brief, and that it ought to be reversed for that reason.

We also contend (B) that, as pointed out above, the Court for the Seventh Circuit was wrong in finding that the record herein materially modified the record in the Dempster case, as this Court will find that record exhibited by the opinions of the Circuit Court of Appeals for the Eighth Circuit and of Judge

Grosscup, the latter of whom also examined that record.

And we further contend (C) that the differences in the two records, whatever they were, were so slight that there is nothing in the differences to defeat the patent sued on.

Our further remarks on contentions B and C, for convenience, will be considered together. We here refer back to pages 23, 24 of this brief, where we quote from Judge Grosscup's opinion saying that the Perkin's wind mill and the additional patents relied on were the same in class and kind, as those in the Dempster record, and were clearly within the art as the Circuit Court of Appeals for the Eighth Circuit understood it and considered it; and where we also show that Judge Grosscup held that the presence of the additional patents would not have changed the judgment of the St. Louis Court. Aside from so classing these new defenses, he further points out that these patents had no function relating to driving the shaft, (pumping rod) or the creation of reciprocal motion, but were for a different purpose altogether, namely, "to keep the wheel in the wind." As to the Perkin's wind mill, he also points out that: "the device principally relied "upon to show prior use is that of the Perkin's "mill." (Trans. p. 78.) "In the Perkin's mill "the fan is attached to, and turns, the large "wheel, into the internal cogs of which mesh "the cogs of the small wheel attached to the "end of a wrist shaft, on the other end of "which is a larger cog wheel, which, by exter-"nal gear, meshes with a small wheel on the "top end of a vertical shaft. It will be ob-"served that the motion imparted is necessa-"rily constant, and that the strain on the axis "of the several wheels is, at all times, uni-"form. There is no period in the revolution

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"of the wheel when the strain on the axis of "either wheel changes directions; no moment "of lost motion. The absence of the pitman "bar attached toward the outer edge of the "wheel, as in the Martin device, eliminates all "changes arising from pulling to pushing ac- "tion, and vice versa. There is in the Per- "kin's device, therefore, whether it is run by "external or internal gear, no danger of "pounding or lost motion. In the case of "either gear the motion would be constant "and noiseless. The Perkin's is, in this re- "spect, similar to the internal gears used in "mowing and harvesting machines, spoken of "by the Court of Appeals. "It is in no sense, "either technically or substantially, a combi- "nation of internal-toothed wheels with the "pinion, pitman or pump of a wind mill, and "therefore, could no more than the internal "gear, used in the mowing and harvesting "machines, have suggested either the purpose "or result of the Martin device. I am not "convinced that the presence of the Perkin's "device in the case before the Circuit Court "of Appeals (Eighth Circuit) would have "changed its judgment. On the contrary, I "feel sure that the Court, holding to its other "postulates, would have classed the Perkin's "device with the others referred to, as being "no such sufficient anticipation of the *thought* "embodied in the Martin invention as to inva- "lidate its patentability." (Trans. p. 81.)

We can add little or nothing to this able, analytical and sound distinction between the Perkin's device and the Martin invention.

As against this, the Circuit Court of Appeals for the Seventh Circuit merely said: "It may "be that the presence of the internal gearing "in other parts of a wind mill ought to be "regarded as of little importance or no more

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"significance in respect to the particular com-
"bination covered by Martin's claim than such
"gearing in familiar use in machines used for
"sawing wood, mowing and other purposes,
"especially since in some of the latter the use
"was to produce reciprocating motion; but
"in view of the fact that in the windmill of
"Perkin's and in numerous others, on which
"patents had been granted before the date of
"Martin's application, external and internal
"gearings were in common use side by side,
"we find it impossible to credit with invention
"a patentee who did nothing but put one of
"the forms in place of the other in a machine
"where both were already present, producing
"by the change no new result, but only im-
"proved effects or relative advantages long
"known to mechanics to be the result of using
"that form instead of the other." (Trans. p. 101.)

From this quotation this Court will see that the Appelate Court for the Seventh Circuit virtually admitted the non-significance of internal gearing in other parts of wind mills and in sawing and mowing machines, but still relied upon the Perkin's device and the additional patents, the essential new matter brought in by the *ex parte* affidavits, and erroneously said there was no new result or effect, such as pointed out by Judge Grosscup, over the Perkin's and additional patents, in neither of which, as also pointed out by Judge Grosscup, was there any conversion of rapid rotary into slow reciprocating motion, the act being accomplished by crossing two dead centers in every revolution, noiselessly and smoothly; but only, as Judge Grosscup stated, "constant motion" in the Perkin's and keeping "the wheel in the wind" in the additional patents.

The only additional points made by the

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Court for the Seventh Circuit from the affidavits are (a) that in the Dempster case the Court laid stress upon the fact that that defendant adopted the Martin construction after seeing the Martin patent in operation, and that instead of such being true in the Stover case, the "testimony" (affidavit) is that the Stover Company adopted its device by "mere accident or incident," without any knowledge "of the Martin patent or mechanism," and that there was no reason shown to discredit this "testimony," (Trans. p. 100;) and (b) that in the Dempster case the Court laid stress on the general introduction of the Martin combination, while the "proof" (affidavits) in the Stover case showed that the prior construction was by no means superseded by the new, which according to the "evidence" (affidavits) in the Stover case constitutes not more than fifteen per cent of the total output on the market. (Trans. p. 99.)

As to the first of these statements, in reference to the Stover Company having adopted the Martin combination without a previous knowledge thereof, the Court was wrong in its statement of fact as shown by the following letters written by the Stover Manufacturing Company in 1892, when notified that it was infringing or about to infringe the Martin patent.

"FREEPORT, ILL., Oct. 4th, 1892.

"H. A. TOULMIN, Esq.,

"Springfield, Ohio.

"Dear Sir:—

"Your favor of the 27th ult. is received and "noted. We have but recently commenced "the manufacture of a wind mill in which we "employ an internal gear. If the use of such "a device is an infringement upon the rights "of your clients, Mast, Foos & Company, we

"are very willing to discontinue. We are not "satisfied, however, that a device of this kind is "covered, but will look into the state of the "art, and if it appears that your clients are "vested with any rights for the exclusive use "of such a device, we will very gladly conform "to their wishes.

"We have exhibited our mill at some of the "fairs, embodying internal gear, which was "completed but a short time ago.

"Your's truly,

"(Signed) W. A. MERRIFIELD.,

"Sec'y. and Treas.

"FREEPORT, ILL., Nov. 1st, 1892.

"H. A. TOULMIN, Esq.,

"Springfield, Ohio.

"Dear Sir:—

"Answering your favor of the 29th ult. will "say that we are still investigating the inter- "nal gear and are not prepared to say definite- "ly what we are willing to do. Thus far, we "have done but little else than experiment "with our internal gear and as the wind mill "season is about over for 1892, and as we have "made but one pattern, and this for a size of "mill very little in demand, your clients need "have nothing to fear for sometime to come "from this source. We will, however, look "into the matter and let you hear from us "later on. Your's truly,

"(Signed) W. A. MERRIFIELD,

"Sec'y. and Treas."

(Trans. pp. 51, 52.)

Thus this defendant knew all about the Martin patent before it began to manufacture, and thus it began to do so in the face of infringement notices; and so its position is not materially different from the position of the Dempster Company as stated in the opinion of

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the Court for the Eighth Circuit on page 11, Trans.

As to the statement that not more than fifteen per cent of the wind mills on the market had internal gears, this Court's attention is called to the fact that such statement by the Court of Appeals in Chicago is based upon the affidavit of W. A. Merrifield. (Trans. p. 37.) But, as he also states that he never knew or heard of Mast, Foos & Company using an internal gear mechanism on their wind mills until after the defendant had introduced its internal gear wind mill "and made it widely known" (Trans. p. 37) which statement is flatly contradicted by his own letters quoted above and written by him some years before his Company was sued, this Court will see how much credit is to be given his statement about fifteen per cent,as against the finding of the Court of Appeals in St. Louis that the Martin combination "immediately went into general use." His further statement that the Stover Co. made the invention "*widely known*," coupled with the fact that Mast, Foos & Co. also brought it into general use, is not consistent with his 15 per cent theory.

INFRINGEMENT.

The Court of Appeals for the Seventh Circuit does not touch upon this question. It apparently leaves it where Judge Grosscup placed it in his decision. He said: "A device "almost precisely like that of the defendant "in this case was held to be an infringement" in Mast, Foos & Company vs. Dempster Mill Manufacturing Company.

"Within the ruling in that case relating to "the scope of the patent, the device of the "defendant in the case under consideration is "clearly an infringement." (Trans. p. 77.)

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The Court of Appeals in St. Louis said: "The terms of the first claim of the patent are "plain and unambiguous. They need no con- "struction, and when taken in their ordinary "signification they fully describe and clearly "claim the combination which the appellee is "using." (Trans. p. 12.) The Court fully discusses the point attempted to be made by Mr. Morrison, who represented the interests of the Stover Company in that case, in its opinion on pages 10, 11 and 12 of the transcript. We presume the same point will be attempted in this Court, namely, that the first claim is limited to the same combination of elements enumerated in claims 2 and 3,—a proposition which that Court overruled.

Martin's specification describes the pitman device in two ways. In setting up of what the invention "consists," column 1, lines 11 to 23, the pitman device is stated to be "an operating pitman" and a "pitman connection." Claim 1 follows this description. It calls for a "pitman"; "a pitman connected with the spur-wheel, and an actuating rod connected with the pitman." Thus the connection between the spur-wheel and the actuating rod is general in claim 1.

In the body of the specification, a detail description is given in which a special form of pitman is described as composed of parts D and F. Claims 2 and 3 follow this latter description. They call for the "pitman bar" F and the "pivoted pitman" D.

The Stover Company uses the first or general form of claim 1. To avoid liability it asked the Circuit Court to construe the first claim in a manner which would make it the same as the 2 and 3 claims; but such construction does violence to the specification as applied to claim 1. Two claims in the same patent in different

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phraseology are not to be construed the same, or in the language of the Courts "are not to be so construed as to render another claim of the patent meaningless."

Cohensy Glass Co., v. *Wharton*, 28 Fed. Rep. 189, 190.

This position the Court of Appeals for the Eighth Circuit sustained, and Judge Grosscup followed it. The Stover wind mill being like the Dempster mill in respect to this combination, it is an infringement.

In conclusion, the following assignments of error, embodied in the petition for the writ of certiorari, are submitted.

(1) In dismissing the bill, the Circuit Court of Appeals for the Seventh Circuit transcended its jurisdiction as a Court of Appeals, by deciding a vital question that had not been, and could not be, decided by the Court below. There had been and could be no hearing or decision in the Circuit Court on the merits, because no evidence had been taken, and the merits of the case were, therefore, not before the Court. The only question that could be or was determined by the Circuit Court was the question whether a preliminary injunction should be granted. This was, therefore, the only question carried up by the appeal. Hence, in proceeding to determine the merits of the whole bill, the Circuit Court of Appeals acted on a question not appealed to it, and acted not as a Court of Appeals, but as a Court for the trial of cases in the first instance. In doing this, it misunderstood and misapplied, *Smith* vs. *Vulcan Iron Works*, 165 U. S., 518, where the Circuit Court was authorized to decide, and did decide, the merits of the whole case, and where consequently, the appeal brought up the whole case. The doctrine of that case does not apply to a mere motion for a prelimi-

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nary injunction based upon *ex parte* affidavits; and it was error for the Court of Appeals here to hold the contrary.

(2) That it was error of law for the Circuit Court of Appeals for the Seventh Circuit to dismiss this bill, and so put your petitioner out of Court, upon mere *ex parte* affidavits; which decision, while a final decision on the merits, was rendered without a trial "according to the course and principles of Courts of equity, (R. S. Secs. 629 and 4921;) and was also a decision at variance in its holding with the decision of the Circuit Court of Appeals for the Eighth Circuit.

(3) That it was error of law for the Circuit Court of Appeals for the Seventh Circuit to make this final decision on the merits without affording your petitioner the right of trial on evidence-in-chief and in rebuttal, taken by the examination and cross-examination of witnesses, as provided in Rules 67 and 68, prescribed by this Honorable Court for the guidance and direction of the Circuit Courts of the United States; and which decision was also at variance in its holding with the decision of the Circuit Court of Appeals for the Eighth Circuit.

(4) That it was error of law for the Circuit Court of Appeals for the Seventh Circuit to so dismiss your petitioner's bill on the merits upon a *mere motion* for a preliminary injunction, while the same matter of right, the validity of claim 1, of the Martin patent No. 433,531, had already been sustained on final hearing by the Circuit Court of Appeals for the Eighth Circuit, as such course has, without trial, displaced a right previously sustained by a regular judgment; thereby also creating a variance on a matter of right not merely *prima facie*, but on one also supported by a judgment

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founded on a final hearing, and which variance is repugnant to the wholesome rule of comity between the Federal Courts, necessary to the proper administration of the Patent Laws as one homogeneous system applicable alike in respect of the patents granted under it in all the judicial circuits of the country. All of which errors and matters of variance have wrought injuries irreparable to your petitioner unless corrected by this Court.

(5) That it was error of law for the Circuit Court of Appeals for the Seventh Circuit to hold, as it did, that your petitioner's said patent was void in view of certain alleged things contained, (as the opinion says) in defendant's *ex parte* affidavits; in other words, it was error to hold that these mere affidavits, which are not legal evidence for such purpose, render its said patent void. We submit that it was incompetent for the Court to so hold on affidavits. It did not find the patent void on its face, yet proceeded to, and did, pronounce a judgment of invalidity on these *ex parte* affidavits. The result was irregularity in procedure and variance with the earlier decision of the Court of Appeals for the Eighth Circuit.

(6) That it was error of law for the Circuit Court of Appeals for the Seventh Circuit not to follow the decision on final hearing by the Court of Appeals for the Eighth Circuit; not to hold the record herein to be the same, in legal effect, as in the Dempster case, or that the differences, if any, were not material; not to sustain the patent in suit, and not to affirm the decision of the lower Court and continue the preliminary injunction; and this Court is respectfully asked to so hold and, if proper and right, to itself affirm the validity of said

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patent and the infringement thereof on the record made herein.

Respectfully submitted,

H. A. TOULMIN,
LYSANDER HILL,
For Mast, Foos & Co.

December, 1899.

NOTE:—We include in an appendix a detail analysis showing the dissimilarity between the Martin patent and the devices shown in the various patents that were pressed upon the attention of Judge Grosscup, and that were shown in certain sketches numbered 1 to 16, which we presume will be presented to this Court also. Judge Grosscup affirmatively pointed out that none of these patents and sketches showed Martin's combination, or suggested it; and the Court of Appeals for the Seventh Circuit did not find that they did contain the combination. See appendix.

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APPENDIX.

THIS CASE AND THE DEMPSTER CASE VIRTUALLY THE SAME.

The points of comparison under this heading are:

a. Similarity of the Dempster and the Stover wind mills.

b. The parties to the two suits.

c. The defenses in the two suits.

1. That the Dempster wind mill and the Stover wind mill are virtually the same, is clear from Judge Grosscup's statement that they are "almost alike."

2. That the parties to this suit were parties to the Dempster suit we hold to be so because of what is pointed out above and below as to the facts, and because of the law.

Lovejoy v. *Murray*, 3 Wall. 1, 18. *Eagle Mfg. Co.*, v. *Miller*, 41 Fed. Rep. 351, 357. *Bradley Mfg. Co.*, v. *Eagle Mfg. Co.*, 6 C. C. A. 661. The decree in the Dempster case has been made *final;* the Master discharged, settlement made and all costs paid by the Dempster Co. For a further showing of the connection of the Stover Co. with the Dempster suit, see Trans. p. 4, bill of Complainant; p. 17, Rayner affidavit; p. 50, Mr. Toulmin's affidavit.

3. As to the defenses we submit:

a. That the Stover Co. had counsel (one of its present counsel) engaged for it in the Dempster case, in which no infringement, anticipation, no invention, and prior use, were set up and attempted to be proved, the Stover Co., falls within the decision in *David Brad-*

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ley Mfg. Co., v. *Eagle Mfg. Co.*, *supra*, holding that a decree is conclusive as to the validity of a patent against a company conducting the defense, even in regard to alleged anticipations not referred to in the suit, since under the issues all anticipatory inventions might have been shown in defense.

b. That as the alleged anticipations in the Dempster suit included an external gear wind mill, a grain binder, a hay spreader or tedder, mowing and reaping machines, sawing machines, and the work entitled "507 Mechanical Movements," and as in this case the same work is cited, and harvesters, churns, hay tedders, and sawing machines, with bicycles, street car seat cleaners, and meat choppers, all for the purpose of illustrating, what nobody ever denied, that internal gear wheels were not new, *per se*, and had been used in various arts, it is clear that the Dempster defenses and the present defenses are the *same* in *kind*, and the same specifically so far as concerns the Williams wind mill patent, largely relied on in the Dempster case, and now set up in this case; and as concerns this book on "507 Mechanical Movements," showing defendant's sketches No. 11 and 12.

DETAIL DISCUSSION OF PATENTS RELIED ON BY DEFENDANT.

The Stover Co. has also brought in a number of patents showing wind mills without any gearing; another batch showing the old-fashioned external gearing disposed of, as a class, by the Court of Appeals in St. Louis; another batch showing wind mill contrivances for keeping the wheels of mills in the wind, which contrivances show internal gear wheels

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per se, all in horizontal positions, none entering into the production of reciprocating motion, with pitmen and actuating rods, and all having nothing to do with transmitting the motion of a pumping mill, such as understood in the Martin patent and shown in the Stover mill. The Stover Co. in its brief below, specially mentioned "Defendant's Exhibit Sketches Nos. 1, 2, 3, 4, 5, 6, 7. 8, 9, 10, 11, 12, 13, 14, 15 and 16."

We answer that Nos. 1, 2, 3 and 4 do not show any gearing of any kind.

That No. 5 is this same patentee's own previous patent showing an old-fashioned external gear arrangement.

That No. 6 (much like No. 5) was especially passed on by the St. Louis Court of Appeals and held not to anticipate, for it lacks the very thing which induces the Stover Co. to infringe. (See opinion of that Court, p. 8 Trans.)

That No. 7 is taken from the patent in suit.

That No. 8, while not showing an internal gear wheel combined with a pitman and pump rod, and not meshing through its internal teeth with the pinion on the wind shaft, but only showing a crown gear with internal teeth working with the pinion on the end of a rotary shaft to keep the wheel in wind, is also too late, as this Hasler patent is dated Oct. 29, 1889, while Martin sold a mill in July, 1889. (Trans. p. 9, near top.—) Other evidence in Dempster record also, as a matter of fact, showed that Martin first reduced to practice his internal gear combination in December, 1888. (Pp. 45, 54, 56, 59, Dempster record, before Chicago Courts as an exhibit.)

That No. 9 shows external teeth on a gear and pinion to rotate an upright shaft for a power mill. It shows a ring with internal

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teeth working with a pinion on the upper end of an upright rotary shaft operated intermittently by a governor. This internal toothed ring is secured to a turntable about half way up the tower and operates to turn the wheel in and out of the wind.

That sketch No. 9 is also defective and misleading, and shows only a part of what is in the patent of Davis in 1841, on which it is alleged to be based.

That No. 10 shows two external tooth pinions, one of them working a rack bar which engages with ratchet pinions on a pulley shaft. This has no likeness to the claim and is subject to the poundings and shocks referred to in the opinion of the St. Louis Court of Appeals as inherent in the old-fashioned external gear mills.

That No. 11 merely shows an example of an internal gear and a pinion, no reciprocating mechanism being illustrated. This very device was in the Dempster case, (Dempster Record, p. 82, Dempster's answer,) and was then known to Mr. Morrison, one of Stover's counsel.

That No. 12 shows no gearing of any kind, and hence no internal gear, while it too was in the Dempster case. (Dempster Record, p. 82 Dempster's answer.)

That No. 13 is a mechanical movement; not a wind mill at all. Its rod *p*, may run up to the upper end of a wind mill tower and and be connected with any kind of a wind mill, whether Martin's kind or any other. If connected to any of the old kinds, without gearing, or with the external gearing, the chugs and shocks would be transmitted to it and soon jerk it to pieces. Or it may be connected with a steam engine or some other motor. It is to be operated upon, and is not itself to de-

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velop and transmit power. It has nothing in common with Martin's invention, and belongs to another art.

That No. 14 is a lawn mower, which is a harvesting machine, of which the Court of Appeals had numerous examples in the Dempster record, showing a cutter bar was actuated in connection with an internal gear, as in the Krum patent, (p. 145 Dempster Record,) and the Brokaw patent, (p. 149 Id.) The St. Louis opinion refers to these examples, (p. 12, latter half, Trans.)

That No. 15 is a sewing machine, and thus falls further away, infinitely, from a wind mill than the harvesting and mowing machines in the Dempster case. Besides Martin's combination and mode of operation are not embodied in this figure. It is on a different system and involves a special arrangement of its own.

That No. 16 is a tread mill, operated by horse power; is designed to increase speed and not decrease it; has not the organization stated in the Martin patent, and belongs to a remote art; but is very much the same so far as concerns a pinion and internal gear wheel as the Hall patent, before the Court in the Dempster case. (P. 144 Dempster Rec.)

This disposes of all the old patents specially selected by Defendant out of a batch of over eighty patents presented by it. His Honor, Judge Grosscup, had all of these patents so relied on, explained to him with great thoroughness, but he found nothing in them which in his judgment would have affected the views of the Court of Appeals for the Eighth Circuit, had all of them, instead of some of them, been before that Court. He said:

"I have looked carefully through all previ-
"ous patents brought specifically to my atten-
"tion as not having been in the case in the

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"Eighth Circuit and am convinced that the "internal gear shown in each of them had no "function relating to the driving of the shaft "or the creation of reciprocal action. The "function of the internal gear appliance in "nearly all of these cases was merely to keep "tne wheel in the wind. I do not feel that the "presence of this information in the mind of "the Court of Appeals would have changed its "judgment respecting the validity of the pat- "ent."

We reproduce below what was submitted in our brief to Judge Grosscup as to these patents, so specially relied on, for the convenience of this Court should it care to analyze them in detail.

Andrew, March 7, 1882:

In this the shaft L is rotated by the external miter pinions D and Q. The rest of the gearing is to keep the wind mill from moving out of line with the wind. There is a tendency to do that because the turn-table would permit the wheel to shift from the wind when the load resists the effort of the wheel to revolve. The patent says its object is "to avoid the side dratts of wind which are common to ordinary geared wind mills" (Lines 13 to 15, Andrew Specification.) The arrangement is also such that when the wind shifts the turntable and the wheel can shift with it. The gears K, O and n, and the gears E, i and h, perform no function with reference to operating the shaft L. Fig. 4 is a modification of the same plan. There is no reciprocating operating rod; there is no pitman; there is no internal gear connected with the pitman; and the Martin combination and purpose, shown in the Martin patent and utilized by the defendant, are wholly absent from this Andrew patent.

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Martin patent, Nov. 14, 1882:

This is another of the same class, in which the object is to prevent "a side draft on the turntable, which tends to shift the wind wheel out of the wind, and causes a consequent loss of power, or the machinery to stop altogether."

In Figs. 1 and 2 there is no internal gear at all. In Fig. 3 the inside of the stationary head is toothed, as shown at N. The pinion M acts as a lock between this stationary head and the pinion K, which latter will attempt to revolve if the wheel starts to swing out of the wind, but will be thus resisted by this pinion M, and the fixed teeth N. The rotating shaft, H, however, receives motion only through external gears, being the gear L, and the gear G.

Fig. 4 is a modification, in which the wind mill shaft E has the same external gear F, working on the same external gear G, which operate through pinions I on an exterior gear L to rotate the shaft H. The internal teeth K merely enter into the scheme for preventing the wheel from shifting out of the wind. There is nothing in common between this patent and the Martin combination

Holcombe, Feb. 6, 1893:

This is a patent whose object is "to hold the wind wheel to the wind when in operation." (Lines 15 to 16, Holcombe's specification, p. 1.) Holcombe uses an external gear C, an external toothed pinion D, and an internal gear T, and an external toothed pinion *b*, the former two shown at the top of the tower, the latter two at the bottom of the tower. He begins and ends with rotary motion. He has no reciprocating motion; he has no pitman connected to an internal gear, at the top of the tower. The internal toothed ring J he uses with two planetary pinions P and O to wind the cord W on the drum S, and to convey the rotary motion

from the shaft E to the exterior gear T. These devices are to keep the wheel from working out of the wind by the tendency of the exterior gear C to travel horizontally around the exterior pinion D, when D is resisted by the load to be operated. In this patent also there is, therefore, nothing in common with Martin.

Coffield, Feb. 27th, 1883:

This is another patent whose object is "to obviate the difficulties arising from the shifting of the wind wheel when opposed by the work to be performed. It is a common thing for the wind wheel of a geared mill, when opposed by the work to be done, to move around from a point that is suitable to the line of direction of the wind to a point that is not so suitable." (Lines 18 to 25, p. 1, Coffield's Specification).

Coffield shows exterior toothed pinions, *b*, *c*, for rotating his shaft *i*. In Fig. 1, he uses exterior toothed compensating gearing at the lower part of his shaft. In Fig. 2, he uses exterior toothed pinions *r*, *s*, *t;* the latter mesh with the former and the gear ring *h* with internal teeth. Now, if the wheel shaft starts to swing out of the wind, the turntable m' will turn the head *f* ', and this in turn will cause the exterior pinions s and p, loosely mounted on stud *q*, to roll bodily around inside the wheel h', which has the effect of counteracting the tendency of the wheel to swing out of the wind. The purpose of this internal toothed wheel *h*', in combination with the planetary pinions, is solely to counteract the tendency of the wheel to depart from the wind when the load resists the rotation of the wheel. So here again there is nothing like the Martin combination, as there is no reciprocating motion, no pitman, operated by an internal gear arranged and operated at the top of the mill, as required in the Martin combination, in connection with the wind mill shaft.

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Holcombe, August 14, 1883:

This patent consists "in a novel arrangement of parts for overcoming the tendency of the wheel to swing or turn out of the wind when a considerable resistance is offered by the machinery driven or operated by the power of the wind wheel." (Lines 8 to 14, p. 1, Holcombe's Specification.) In this patent the external gears F, E, H, and I, Fig. 1, are used to give rotary motion to throw the wheel back into the wind should it move very much. A ring A, with internal teeth is fixed to the turntable B, and by the action of the pinion *b* the wheel is brought back to the wind. This is not a rotating internal gear wheel, but a ring which is fixed to the turntable and has only slight rotary oscilations for a purpose wholly apart from that of transmitting power. Here again there is no reciprocating motion, no pitman, no internal gear connected to and operating on a reciprocating rod in connection with the wind mill shaft.

In the modification shown in Fig. 2, the same object is sought as by Fig. 1 of the Holcombe patent; but the Martin combination is wholly absent.

Coleman and Turner, May 12, 1885:

In this patent the tubular power shaft *r*, is rotated by external gears *a'* and *a*, until, through a system of gears, this power ends in rotating the last shaft with the belt. If the wind wheel tends to swing out of the wind, the gears A and D turn with it and carry the shaft *e'* and it gears E and *f*, in a circle around the power shaft, more or less, according to the distance the wheel shifts from the wind. In operation the gears A and D exert an equal leverage on the gear E and the resistance of the work being done by the shaft r", does not carry the wheel out of its position with respect

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to the wind. The sole purpose of the wheel A with its internal teeth is to compensate for any effort of the wheel to swing out of the wind. Here again the Martin combination is wholly absent, there being no reciprocating motion, no pitman, no internal gear operating the pitman connected with a reciprocating actuating rod, and no dead centers with pulling and pushing strains, and the driving power not being derived from the wind mill shaft through such internal and reciprocating connections.

Pattison, July 7, 1885:

The shaft H' is turned by external toothed pinions I, I'; the system of external gears I'', I'' ', I'' '', and I'' '' ', are actuated by the turn-table, should the wheel swing from the wind, and this swinging is counteracted or overcome by the action of the planetary pinions I^7, I^8, in the box or gear T. The effect is to keep the wheel in the wind, but this again is as remote as possible from the Martin combination, there being no reciprocating motion, no pitman, no internal gear operating the pitman, which in turn is connected with a reciprocating rod organized as in the Martin patent.

Newell, August 3, 1886:

This is another patent in which the object is to always keep the wind wheel "in the direction of the wind." (Lines 10 to 11, p. 1, Specification). The upper part of this mill has nothing but external toothed gears and pinions as shown in Fig. 1. The motion from the wind wheel is transmitted through the shaft A, gear E and pinion F, shaft G, pinions O and M, and shaft N. Should the wheel swing out of the wind then the gear B acts on the gear C and hollow shaft D, to cause the internal toothed hub or wheel J to act on the wheel K. The result is that the wheel is brought back into the wind by causing its motion out of the wind to be resisted through this gearing.

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All of these patents, from Andrews to Newell, are thus seen to be, each and all, upon a wholly different line of thought and for a different purpose from the Martin invention. No one of them dealt with transmitting the rotary motion of the wind mill shaft, to a reciprocating actuating rod, slowing down the motion as it did so, through the instrumentality of a pinion on the wheel shaft, and an associated internal gear wheel operated by the pinion, and itself carrying the pitman which runs to and connects with the reciprocating rod. In other words, there is nothing in all defendant's record that affects the first claim, as construed by the Court of Appeals at St. Louis.

All of these patents go solely to the point of providing gearing for overcoming side draft, that is, the tendency of the wheel to turn out of the wind when resisted by the load. They are for that and nothing else.

PERKINS WIND MILL.

As to this power mill, not a pumping mill, which latter is in controversy in this case, we ask the Court to consider what is stated by Judge Grosscup and in the affidavit of (the now late) Mr. Charles A. Bauer, (former) General Manager of The Warder, Bushnell & Glessner Company, of Chicago, Ill., and Springfield, Ohio. Mr. Bauer was admittedly one of the ablest mechanical engineers, if not the ablest, in the State of Ohio. He was wholly disinterested in this case, and his statement was made from this standpoint as such an engineer.

Judge Grosscup said:

"I am not convinced that the presence of the Perkins device in the case before the Circuit Court of Appeals would have changed its judgment. On the contrary, I feel sure that that Court, holding to its other postulates,

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would have classed the Perkins device with the others referred to, as being no such sufficient anticipation of the thought embodied in the Martin invention as to invalidate its patentability.

"The motion for an injunction must, therefore,be sustained." (*Trans. 80*).

Mr. Bauer says, Trans. 71:

"My comparison of these Martin and Per-"kins structures and my careful consideration "of them, have resulted in the following con-"clusions:

"In the first place, when one institutes a "comparison of two machines, the first thing to "consider is, what is to be accomplished; next, "how it is to be accomplished and what mech-"anism or groupes of devices are used in the "respective apparatus.

"Looking at the Martin and Perkins ma-"chines for what is to be accomplished, I find "that Martin was seeking to accomplish or pro-"duce reciprocating motion by applying rotary "power at the upper end of a high tower called "a wind mill tower, and to utilize that motion "a long distance from the point of its applica-"tion, namely, at the bottom of the tower.

"Then I find that Perkins was seeking to "take rotary motion from a high plane, thence "to carry this rotary motion down to a lower "plane, and then to carry it off in a horizontal "plane.

"The first fact I therefore arrive at is that "the two men were working in different fields "of motion, in the sense of mechanics, and were "working for different objects.

"This disposes of one primary factor in in-"vestigations of this kind.

"The next thing is how these different ob-"jects are accomplished and by what mechan-"ism. Martin employs a compact, simple

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"group of devices. This group includes a pit-
"man, an internal gear wheel, which performs
"the double office of a gear wheel and a crank,
"a pinion on the wind mill shaft which meshes
"with the internal gear wheel, and through it
"operates, and slows down the motion of, the
"pitman, and lastly, a long reciprocating rod
"or bar connected to the pitman at its upper
"end and designed to connect directly with the
"pump at the lower end. This group *ex*cludes
"all external gear wheels, which *ex*clusion is
"one of the purposes Martin had in view. The
"result is a compact, simple machine, without
"a single feature that could be mechanically
"dispensed with.

"Returning to the Perkins machine, I find
"that he accomplishes his purpose to produce
"rotary motion, as I have stated, by another
"group, and a different group of mechanical
"devices. He employs an internal toothed
"ring which speeds up a pinion. This pinion
"has an external toothed miter gear wheel on
"its shaft which turns in a vertical plane.
"Then he has an up ight shaft with an exter-
"nal toothed pinion which meshes with this ex-
"ternal toothed miter gear. Thus this pinion
"rotates in a horizontal plane. This long up-
"right shaft carries, at its lower end, another
"external toothed pinion or gear wheel. Then
"Perkins introduces another long horizontal
"shaft, from which he takes off rotary motion.
"This lower horizontal shaft also has an exter-
"nal toothed pinion or gear wheel, and which
"meshes with one on the lower end of the up-
"right shaft.

"The second fact that I therefore arrive at
"is that the two groups of mechanisms are dif-
"ferent. Perkins includes, and cannot oper-
"ate without, the very external gears which
"Martin eliminated. Perkins does not move

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"the long rod up and down, and if he did it "would not rotate his lower horizontal shaft; "and if he did its pinion would not keep in "mesh with the upper miter gear. Nor do I "lose sight of the fact that if Perkins "takes rotary motion from the lower horizon- "tal shaft by the addition of still further ro- "tary devices, he may operate a pump. That "does not, however, enter into the true com- "parison of the mechanical groups employed.

"The result is that I am forced to find that "the Martin group and the Perkins group are "broadly unlike, one belonging to one cate- "gory, namely, reciprocating apparatus, and "the other t › another category, namely, rotary "apparatus.

"These two subdivisions in the science of "mechanics are so widely separated that "whole factories and large investments may "be and are engaged in the production of ma- "chines in one of these categories, and other "large factories may be and are engaged in the "production of machines in the other of these "categories. This disposes of the second fac- "tor in this inquiry.

"I am, therefore, upon this analysis, and "comparison, brought to the true and safe con- "clusion, to which such analysis and comparison "always lead, namely, that the Martin and the "Perkins machines are mechanically unlike in "principle, mode of operation and results, and "are under distinct mechanical laws, assign- "able to different fields or catagories in the "science of mechanics, to which science I have "devoted all of my manhood.

"I make this statement before and to this "honorable Court, I wish to say, without any in- "terest, directly or indirectly, in this contro- "versy, and without compensation or reward of "any kind, but for the sole and simple purpose

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"of stating conclusions to which I have arrived "by the method of comparison above stated, "and further I saith not."

See also on Perkins mill, statements of Coffield, p. p.49, 50, Trans.

There remains but one other defense or alleged early machine to be referred to. (Trans. p. 33.) On p. 49, we also reproduced an affidavit and the same cut, offered by us.

This machine is a sawing machine, and so falls within the same category (and, indeed, is not materially unlike, so far as this case is concerned,) as the sawing machines in the Dempster case, and considered by the St. Louis Court of Appeals.

Mr. Neasy says in his affidavit (p. 49), referring to this sawing machine, that his company never manufactured, sold or dealt in wind mills of any kind during the twenty-seven years of his connection with it previous to December, 1897. Defendant added a hand sketch to the cut showing this sawing machine. (p. 33).

By comparing his hand sketch with the Hall patent, (Dempster record and this record) the Court will see that supposing the former was pertinent at all, it has been virtually passed upon by the St. Louis Court of Appeals.

Lastly, see the sketch produced by defendant (p. 26, Trans.) This sketch represents a gear*less* windmill, formerly made by complainant, your petitioner. It has no gear of any kind, and is referred to in the Martin patent sued on. It was to get a back-gear mill, without "shocks," "chugs," etc., that this internal gear mill was invented and this old gear*less* mill was dropped. The mill from which the sketch was made, was before the St. Louis Court. (See Trans. p. 50, near bottom, and p. 51, near top).

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We think this disposes of all of the alleged anticipations, and the Court will see, as the St. Louis Court of Appeals saw, and as Judge Grosscup saw, that, in the language of said Court of Appeals: * * * "No one had ever "combined one of these internal-toothed wheels "with the pinion, pitman and pump of a wind "mill until Martin made his invention." * * * "Moreover the combination of Martin immedi- "ately went into general use." * * * "The "probative force of the patent and of the facts "to which we have averted constrain us to "hold that the combination described in its "first claim arose to the dignity of an inven- "tion and was properly secured by the patent."

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